

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/667,250	06/20/96	HOLCOMBE	M 284BAKER448

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C5M1/0818

EXAMINER	
DANG, H	4
ART UNIT	PAPER NUMBER

3506

DATE MAILED: 08/18/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/667,250	Applicant(s) Holcombe
	Examiner Hoang C. Dang	Group Art Unit 3506

Responsive to communication(s) filed on _____.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1, 2, 4, 7-10, and 12-27 is/are rejected.

Claim(s) 3, 5, 6, and 11 is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on Jun 20, 1996 is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3506

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 4, 7-10 and 12-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following expressions have no proper antecedent basis: "said motor" (claim 4, line 3); "said second position" (claim 7, line 6); "the well drilling and completion operations" (claim 12, line 2); "said body" (claim 13, lines 2-4); "its said second position" (claim 18, line 5); and "the remotely mounted apparatus" (claim 23, lines 5-6).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1, 2, 12, 13, 23 and 24 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Baugh et al '390.

Art Unit: 3506

The claimed structure or method steps read exactly on the reference's when members (42) and (54,62,64,66,70,72, etc.) of Baugh et al are respectively considered as "driver" and "transmission" as recited.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 12, 13, 23 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 5,435,390. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed "driver" and "transmission" do not distinguish from the "biasing element" and "linkage" of the claims of the U.S. patent '390. In any event, one of ordinary skill in the art would have readily recognized that the use of a "driver" and a "transmission" as broadly recited in claims 1, 2, 12, 13, 23 and 24 is necessary to actuate the claimed apparatus of the U.S. patent '390.

6. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686

Art Unit: 3506

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Allowable Subject Matter

7. Claims 3, 5, 6 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 4, 7-10, 14-22 and 25-27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Drawings

9. The drawings are objected to because in figures 1, 3, 4, 12a and 12b, parts in section are not properly crosshatched. Correction is required.

Art Unit: 3506

10. Applicant is required to submit a proposed drawing correction in response to this Office action. However, formal correction of the noted defect(s) can be deferred until the application is allowed by the examiner.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Hoang Dang, whose telephone number is (703) 308-2149. The examiner can normally be reached on Monday-Friday from 9:15 AM to 5:45 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tamara L. Graysay, can be reached on (703) 308-2144. The fax phone number for this Group is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.



HOANG C. DANG
PRIMARY EXAMINER
ART UNIT 3506

H. Dang/hcd
08/14/1997
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